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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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081539,046 11/03/96 BAUER

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EXAMINER

ENTERED

ART UNIT

PAPER NUMBER

3204

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DATE MAILED: 11/26/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/22/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.

Of the above, claims 1-5, 8-11 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 6, 7 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 08/506255; filed on 7/27/95.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

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Part III DETAILED ACTION

Election/Restriction

1. Applicant's election **without** traverse of Group II, specifically the species IIb, in the response filed October 22, 1996 (paper no. 4) is acknowledged. Applicant agrees with the Examiner's statement in paper no. 3 that claim 6 is generic, and further asserts that claim 7 reads on the elected species. Therefore, claims 6 and 7 have been examined. Claims 1-5 and 8-11 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions (claims 1-5 and 11) and to nonelected species (claims 8-10).

Priority

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119. The certified copy has been filed in parent application, Serial No. 08/508,255, filed on July 27, 1995.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying

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this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed alterations have been made to the oath or declaration, specifically to the post office address of the second inventor (see 37 C.F.R. §§ 1.52(c) and 1.57).

Drawings

4. The drawings are objected to because in Figures 1a-c, numerals 1 and 2 (as described on page 4, line 16 are not shown. Further, in Figure 4, it seems that the lead line for numeral 22a should have an arrowhead since it indicates the sliding assembly in general. Further, numeral 18 described on page 6, line 4 is not shown and it seems that it should be added (along with a lead line having an arrowhead) to Figure 5. Correction is required.

Specification

5. The title of the invention is inaccurate based on the elected invention, and it is suggested to simply delete "METHOD AND" from the title.

6. The disclosure is objected to because of the following informalities: On page 4, last line, "consist of" appears to be inaccurate since the cutting edges do not include a slot but rather it appears that they are formed by the slot. On page 5, line 1, it seems that "narrow" should read --narrows--; in

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line 10, it seems that "arms" should be singular since element 2a only has one arm. On page 5, line 5, "6c" appears to be incorrect with respect to Figure 3, and in line 6, "3c" appears to be incorrect with respect to Figure 3. On page 7, line 1, "25" has already been used to indicate the left end of the slot (page 6, line 19) and it's not clear as to what "plate insertion hole" refers; in line 8, "18a" appears to be incorrect and it seems that it should read --18d--; in line 14, "3c" appears to be incorrect and it seems that it should read --3d-- as shown in Figure 6. Appropriate correction is required.

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

It is not clear from the disclosure how the pieces are being separated and thus it is not clear whether sufficient support is provided in the specification for the term "cutting" as set forth in the claims. It is not clear from the specification whether the portions of the plate are separated by cutting (i.e.

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shearing), tearing or breaking. Throughout the disclosure the term "cutting" is used to describe the separation. However, it is not clear how a cutting action which would completely cut through the plate is accomplished in any of the embodiments, particularly the schematic shown in Figures 1a-c. On page 4, beginning in line 17, it is described that relative rotation of more than 15° of the blocks will result in the plate 3 being cut. However, a relative rotation of a little more than 15° will result in only a partial shearing action. Further, as shown in Figure 1c, the respective blade pairs appear to remain spaced through the cutting action, and thus it is not clear how the portion in the immediate vicinity of the axis (4) is sheared. Clarification of the separating action is required.

Claim Rejections - 35 USC § 112

8. Claims 6 and 7 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

9. Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 1, "cutting" is indefinite for the reasons described above under paragraph 7; in lines 3-4, "having cutting

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edges" is vague as to what it refers (i.e. does each shearing element have plural edges or do the shearing elements together have plural cutting edges), particularly in view of line 4 which recites that the cutting edges directly touch one another (it is noted that only one cutting edge from one of the shearing elements touches one cutting edge from the other shearing element).

In claim 7, line 2, ✓ "a cutting edge" is vague and indefinite as to whether it refers to one of the cutting edges referred to in claim 6 or to another cutting edge; in line 4, ✓ "narrowing toward the center" is vague and indefinite since it is not clear as to what it refers (it appears to be directed to the cutting edge when it seems that it should be directed to the slot); in lines 4-5, ✓ "a handle attached to each of the discs" is vague as to what is being set forth, for example, it is not clear whether one handle is connected to each disc or whether each disc has a respective handle connected thereto.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claim 6 is rejected under 35 U.S.C. § 102(b) as being anticipated by Stolpe.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b, l', l') for rotating the elements counter to one another.

12. Claims 6 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schweitzer.

Schweitzer discloses a cutting apparatus with every structural limitation of the claimed invention including an upper shearing element in the form of a disc (78), a lower shearing element in the form of a disc (76), and means (including 10, 52, 54 and 28) for rotating the elements counter to one another, wherein each of the shearing elements has slot (96, 94) with a cutting edge which extends from the outer periphery toward the center and narrows toward the center, and a respective handle (88, 82) connected to each of the discs.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

14. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Stolpe in view of Schweitzer.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ernst, Ross, Peyre and Werner disclose cutting devices with shearing elements that rotate with respect to each other to cut a workpiece. Kelsea, Burns and Pelosi, Jr. et al. disclose tools with structural features which are similar to the elected species.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.



Clark F. Dexter
Patent Examiner
Group Art Unit 3204

CFD
November 25, 1996